

REMARKS

This paper responds to the office action dated March 5, 2008. Reconsideration is hereby requested in view of these remarks.

1. Status of the Claims

Claims 25-26, 29-34 and 37-40 remain pending in this application. Claims 25, 30-31, 33, and 38-39 stand rejected under 35 U.S.C. § 103 as being obvious over Kraft (US 2002/0107009) taken alone. Claims 29 and 37 stand rejected under 35 U.S.C. § 103 as being obvious over Kraft in view of Schmidt (US 6,522,894). Claims 26 and 34 stand rejected under 35 U.S.C. § 103 as being obvious over Kraft in view of Shimizu (US 2002/001236). And claims 32 and 40 appear to stand rejected as being obvious over Kraft taken alone.

All of these rejections are traversed.

2. Claims 25 and 33

The obviousness rejection of independent claims 25 and 33 must be withdrawn for at least the following reasons: (1) Kraft does not disclose a “*safe volume profile providing a default volume setting selected to reduce risk of damage to a user’s hearing*,” and (2) the rejection improperly relies upon “official notice” in violation of MPEP 2144.03.

A) Kraft Does Not Disclose a “safe volume profile”

The Office Action alleges that Kraft discloses the claimed “*safe volume profile providing a default volume setting selected to reduce risk of damage to a user’s hearing*” by referring to paragraphs [0036] and [0037] of Kraft. These portions of Kraft are set forth immediately below.

[0036] The user may choose with the first item “selection” whether the mode selection is to take place manually or automatically. This is indicated by the box 27. If the user here selects automatic mode selection 28, the CPU checks the control parameters and selects mode in response thereto. The phone then returns to the main menu with the menu item “modes” display text (stage 25).

[0037] If manual mode selection is selected, it is asked in stage 29 which mode the user wants, and here “default” mode is suggested as default. If the user then selects this or another mode, the phone remains in this mode until another is selected or until the automatic mode selection is selected. The phone then returns to the main menu with the menu item “modes” display text (stage 25).

Paragraph [0036] of Kraft discloses that the user of Kraft’s telephone may chose whether mode selection is to take place manually or automatically. Paragraph [0037] discloses that when the phone is in “manual” mode, then the user is able to manually put the phone into one of the available modes. The phone will then remain in this mode until another mode is manually selected, or until the user puts the phone back into automatic mode selection.

There is absolutely nothing whatsoever in these two paragraphs of Kraft that relates to the claimed “safe volume profile providing a default volume setting selected to reduce risk of damage to a user’s hearing.” In fact, there is no disclosure in Kraft that even relates to the concept of protecting the hearing of a mobile device user. This teaching is completely missing from Kraft, in part, because Kraft’s telephone does not include a loudspeaker that is capable of producing sufficient acoustic signal to damage the user’s hearing. The Office Action admits as much when it states “Kraft fail to disclose of the specific wherein the phone having a first speaker and a second speaker. . . and the second speaker capable of generating a larger acoustic output signal than the first speaker.” (Office Action at 3) Kraft’s telephone would have no need for the claimed “safe volume profile” because, as the Office Action admits, it does not disclose a

loudspeaker. Therefore, because the claimed “*safe volume profile*” is clearly missing from Kraft, the obviousness rejection must be withdrawn.

B) The Office Action Improperly Relies Upon “Official Notice”

Applicants specifically traverse the assertion of “official notice” in the Office Action in finding that claims 25 and 33 are obvious over Kraft, taken alone.

At page 3 of the Office Action, it is admitted that “Kraft fail to disclose of the specific wherein the phone having a first speaker and a second speaker, the first speaker for use in a handset mode of operation in which the mobile phone is placed in close proximity to a user’s ear and the second speaker for use in a handsfree mode of operation, the second speaker capable of generating a larger acoustic output signal than the first speaker.” Relying only upon the doctrine of “official notice,” the Office Action then concludes that “official notice is taken the concept of having the phone with either one or multiple speakers for generating different mode of operation is simply inventor’s preference.” Applicants maintain that the Office Action has improperly relied upon the doctrine of “official notice” here because the asserted “facts” are not capable of instant and unquestionable demonstration and also because the Office Action fails to consider the claim as a whole.

MPEP 2144.03 makes clear that official notice without documentary evidence to support an examiner’s conclusion is permissible only in some circumstances: “[o]fficial notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known.” (MPEP 2144.03.A)

Here, the Examiner essentially asserts that it is common knowledge to have a mobile device with first and second speakers, where the second speaker is a loudspeaker capable of

generating a larger acoustic output signal than the first speaker, and where each speaker is assigned a different operating mode. Applicants specifically traverse the conclusion that this was well-known in the art at the time of applicant's invention, and also specifically traverse the conclusion that the prior art teaches that "the purpose of this would have been to provide safe volume level during operation of different mode" as stated at page 3 of the Office Action.

The Examiner must provide documentary evidence in the next Office Action if the rejection of claims 25 and 33 is to be maintained on this "office notice" basis. (MPEP 2144.03; 37 CFR 1.104(c)(2); and *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test.))

3. Claims 26, 29, 32, 34, 37, and 40

The obviousness rejections of claims 26, 29, 32, 34, 37 and 40 must be withdrawn because the Office Action fails to set forth any articulated reasoning to support the legal conclusion of obviousness. As stated in M.P.E.P. 2141, "[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." The importance of clearly articulating the rationale for a conclusion of obviousness was recently emphasized by the Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ____ (2007), stating that "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

Regarding claims 29 and 37, for example, the Office Action at page 6 admits that the subject matter of these claims is not disclosed in Kraft and therefore relies upon Schmidt as allegedly providing this missing teaching. In so doing, however, the Office Action runs afoul of

the Supreme Court's admonition in KSR because the Office Action does not provide any articulated reasoning or any rational underpinning to support the legal conclusion of obviousness. Instead, the Office Action merely repeats the portions of the claim language that is allegedly present in each reference. This is clearly improper. How can the claim language itself be the "articulated reasoning" in support of a conclusion of obviousness? This is exactly the type of "mere conclusory statements" that the Supreme Court indicated could not sustain a rejection on obviousness. The Office Action repeats this same type of "mere conclusion" in finding that claims 26, 32, 34 and 40 are obvious. Therefore, because all of these rejections lack any articulated reasoning in support of the conclusion of obviousness, the rejections must be withdrawn.

This application is now in condition for allowance.

Respectfully submitted,
JONES DAY

A handwritten signature in cursive script that reads "David B. Cochran". The signature is written in dark ink and is positioned above a horizontal line.

David B. Cochran
Reg. No. 39,142

Jones Day
North Point, 901 Lakeside Avenue
Cleveland, Ohio 44114
(216) 586-7029